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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,939	06/15/2004	Paul Joseph McMahon		1274

7590 06/15/2006  
Paul McMahon  
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EXAMINER

ALHIJA, SAIF A

ART UNIT PAPER NUMBER

2128

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/800,939

Applicant(s)

MCPAHON, PAUL JOSEPH

Examiner

Saif A. Alhija

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claim 1 has been presented for examination.

**Abstract Objection**

2. i) The abstract of the disclosure is objected to because it is not a single paragraph.

Correction is required. See MPEP § 608.01(b).

ii) The Applicant appears to use the phrase “composition of matter” with regards to data. It is noted that composition of matter is defined by the Office to be one of the statutory classes and relates to the composition of alloys rather than data.

**Drawings Objection**

3. The drawings are objected to because they do not contain figure labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Specification Objection**

4. The disclosure is objected to because of the following informalities: The specification does not contain a background, brief description of figures, etc. The specification does not comport to proper U.S. practice. See MPEP 608.01. Appropriate correction is required.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claim 1 is rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

i) The claim recites a method but does not appear to have corresponding method steps; therefore the claim would not have a useful, concrete, and tangible result.

**Claim Rejections - 35 USC § 112**

*The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims as a whole are generally replete with difficulties under 35 U.S.C. 112, second paragraph.

a) **Claim 1 is rejected** as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

i) The claim appears to be merely a preamble. Applicant has stated the purpose of the invention and a vague generalization of its methodology but the claims do not comport to proper U.S. practice with a preamble separated from its corresponding method steps.

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ii) The claim contains 2 sentences. The second sentence being a narrative statement by the Applicant that the invention is novel which also does not comport to proper U.S. practice.

b) The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only.

7. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

#### **Claim Interpretation**

8. Claim 1 reads as "What I claim as my invention (named "Submarket Analyst") is the creation of a universally recognized and definitive paradigm for identifying and standardizing real estate location quality; enabling realtors to effectively and quickly communicate the qualitative economic attributes of any real property's location to their clients, prospective clients, and other realtors in the terminology that they understand most - and in an objective graphic representation. This is achieved through specific statistical classification methodology of per capita income census data, and the resulting graphical

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representation of such demographic data on a map using a GIS (geographic information system). As I, Paul McMahon, have never seen any such real estate location quality identification method that is definitive, universally recognized, graphically represented, and quickly distributed - prior to this invention by myself - I claim this invention as my own.”

The claim is interpreted to be a method of identifying and standardizing real estate location quality utilizing economic attributes of specific locations and providing a graphical representation of identified locations.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**9. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reynolds “An Introduction to Geographical Information Systems”, hereafter referred to as Reynolds.**

**Regarding Claim 1:**

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**Reynolds discloses** a method of identifying and standardizing real estate location quality utilizing economic attributes of specific locations and providing a graphical representation of identified locations.

**(Page 6, Section E. Figure 4)**

**10. Claim 1 is rejected** under 35 U.S.C. 102(e) as being clearly anticipated by **Morimoto et al.**

**“Region Calculation Method, Spatial Data Mining Apparatus, Geographical Information Display Apparatus, Spatial Data Mining System and Storage Medium”, U.S. Patent No. 7,010,564, hereafter referred to as Morimoto.**

**Regarding Claim 1:**

**Morimoto discloses** a method of identifying and standardizing real estate location quality utilizing economic attributes of specific locations and providing a graphical representation of identified locations. **(Column 1, Lines 15 – Column 2, Line 59. Figures 3A and 3B)**

**Conclusion**

**11. All Claims are rejected.**

**12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saif A. Alhija whose telephone number is (571) 272-8635. The examiner can normally be reached on M-F, 11:00-7:30.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kamini Shah can be reached on (571) 272-2279. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.**

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAA

June 8, 2006

**HUGH JONES Ph.D.**  
**PRIMARY PATENT EXAMINER**  
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